

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
Pramil, S.R.L. (Esapharma))	
)	
Petitioner,)	
)	
vs.)	Cancellation No. 32,341
)	
Michel Farah)	
)	
Registrant)	
_____)	



01-08-2002

U.S. Patent & TMOtc/TM Mail Rpt Dt. #01

REGISTRANT'S MOTION TO TAKE ORAL DEPOSITION OF PETITIONER

COMES NOW the Registrant, Michel Farah, ("Registrant"), and pursuant to 37 C.F.R. §2.120(c)(1), requests that this Board order that the deposition of Petitioner, Pramil S.R.L. (Esapharma) ("Petitioner") be taken by oral examination, and not by written question. Pursuant to said Rule 2.120(c)(1) it is respectfully suggested that good cause exists for entry of the requested Order, as more fully set forth below.

Petitioner is a foreign entity, located in Italy. (Petition to Cancel, p. 1). Registrant concedes that absent a showing of good cause, the standard method of obtaining the deposition of a foreign Petitioner is by written question. Id. Under this procedure, the Parties' attorneys exchange written questions and objections, and arrive at a final list of written questions to be posed by both sides. 37 C.F.R. §2.124. The questions are then forwarded to

Petitioner, who must answer them under oath. Id. Accordingly, the Petitioner is able to review and prepare answers to the specific questions with the assistance of its attorneys. Moreover, the traditional availability of follow-up questions to evasive or incomplete answers is not provided for. While this method of deposition may be sufficient wherein the issues are simply ones of likelihood of confusion between similar, legitimately used marks, this proceeding does not involve such traditional, genuine business disputes over the affect of the respective Parties' marks on the consuming public.

Rather, the instant case involves allegations by Petitioner which amount to essentially an admission that Petitioner has been counterfeiting Registrant's registered trademark. Petitioner's position is apparently that Petitioner has used the mark in question first in commerce, and that the Registrant lied in its trademark application regarding Petitioner's first dates of use. Registrant vehemently denies such false accusations. In essence, then, this proceeding amounts to counterfeiting litigation being held before this Board, instead of a Court of law, wherein the Parties' contentions are likely to be determined based at least in part upon the credibility of testimony.

In such instances, the availability of face-to-face, oral examination is crucial. It cannot be expected that Petitioner will

provide complete, non-evasive answers to written questions in the context of this "counterfeiting" litigation.

In situations such as the instant case, wherein face-to-face oral depositions are crucial to defeating factual allegations believed to be false or incomplete, (in this case the allegations in the Petition to Cancel itself are believed to be deliberately false and incomplete), this Board has found sufficient cause to justify the use of face-to-face, oral depositions, as opposed to written questioning of foreign parties. See, Orion Group, Inc. v. The Orion Insurance Co., P.L.C., 12 USPQ2d 1923 (TTAB 1989).

The undersigned has attempted in good faith to resolve this issue with opposing counsel, but has been unable to do so.

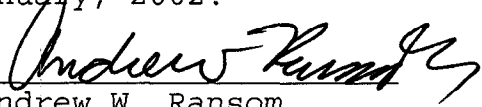
WHEREFORE, Registrant requests entry of an Order requiring Petitioner to appear for oral deposition in this action, in Italy if necessary, upon a Notice of Deposition pursuant to Fed.R.Civ.P. 30(b)(6) to be issued by Registrant.

Dated: January 8, 2002

Respectfully submitted,
By: Andrew W. Ransom
John Cyril Malloy, III
Florida Bar No. 964,220
Andrew W. Ransom
Florida Bar No. 964, 344
Counsel for Defendants
MALLOY & MALLOY, P.A.
2800 S.W. Third Avenue
Miami, Florida 33129
Telephone (305) 858-8000
Facsimile (305) 858-0008


CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing document was served upon, Donald L. Dennison, Esq., DENNISON, SCHEINER, SCHULTZ AND WAKEMAN, 1745 Jefferson Davis Highway, Suite 612, Arlington, Virginia 22202, via first class United States mail, postage pre-paid, this 8th day of January, 2002.


Andrew W. Ransom
Florida Bar No. 964,344

CERTIFICATE OF MAILING

I HEREBY CERTIFY that an original and three copies were deposited by United States Postal Service Express Mail, label no. EL 920394329 US _____, in an envelope addressed to: Assistant Commissioner for Trademarks, Attn: T.T.A.B., "Box TTAB", 2900 Crystal Drive, Arlington, Virginia 22202-3513, this 8th day of January, 2002.


Andrew W. Ransom
Florida Bar No. 964,344